

REMARKS

Initially, Applicant notes that the Examiner indicates in the Advisory Action that Applicant's reply has over the 35 USC 112, first paragraph, rejection of Claims 1, 3-13, 16 and 17. Applicant thanks the Examiner for this indication.

Further, Applicant notes that claim 1 has been amended to make an editorial change by inserting a semicolon after "Z is C=O".

With respect to the previous amendment requiring administration to a mammalian subject in need of reduction of body weight, Applicant notes that the Examiner indicates in the Advisory Action that such an amendment is new matter which lacks support in the specification. However, Applicant disagrees with the Examiner's indication that the amendment to the claims requiring administration to a mammalian subject in need of reduction of body weight is new matter which lacks support in the specification. In particular, Applicant submits that the last paragraph on page 26 in the specification discloses that Fig. 1 shows the changes of body weight from the pre-values in each group at 3 weeks after the initiation of the administration, and that "[a]s shown in Fig. 1, body weight reductions were observed in all test groups while an increase was observed in the control group" (emphasis added). Applicant also submits that one of ordinary skill in the art would understand that in the experimentation in the specification, the claimed invention was not administered to reduce body weight in a subject who did not need body weight reduction, particularly since the claimed invention is directed to a method for treating obesity (and one of ordinary skill in the art knows that obesity is a condition of excess weight); rather, it was administered to reduce body weight in a subject in need of body weight

reduction. Accordingly, Applicant submits that a skilled artisan considering the specification including the above disclosure would understand that the claimed invention involves administering the recited compound to a subject in need of reduction of body weight.

In addition, Applicant notes that claim 20 has been added corresponding to claim 1 except for replacing “administering to a mammalian subject in need of reduction of body weight an effective amount of a prostaglandin compound as shown by the following general formula (I):” with “administering to a mammalian subject in need of treatment for obesity an effective amount of a prostaglandin compound as shown by the following general formula (I) to reduce body weight:”. Applicant submits that the recitation “to reduce body weight” is supported by the last paragraph on page 26 in the specification. Also, Applicant submits that the step of administering to a mammalian subject in need of treatment for obesity an effective amount of a prostaglandin compound of general formula (I) to reduce body weight is not inherent in or obvious over the cited art.

Also, claim 21 has been added corresponding to claim 1 except for replacing “A method for treating obesity in a mammalian subject which comprises administering to a mammalian subject in need of reduction of body weight an effective amount of a prostaglandin compound as shown by the following general formula (I):” with “A method for reducing body weight in a mammalian subject which comprises administering to a mammalian subject in need of treatment for obesity an effective amount of a prostaglandin compound as shown by the following general formula (I) to reduce body weight:”. Applicant submits that the body weight reduction recitations are supported by the last paragraph on page 26 in the specification, as discussed

above. Also, Applicant submits that claimed method is not inherent in or obvious over the cited art.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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